



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,357	12/10/2003	Shimon Tsurgil	20070/1200636-US1	8712
7278	7590	04/28/2005	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			NGUYEN, SON T	
			ART UNIT	PAPER NUMBER

3643

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/733,357

Applicant(s)

TSURGIL, SHIMON

Examiner

Son T. Nguyen

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-3,6,9-13** are rejected under 35 U.S.C. 102(b) as being anticipated by Ag. Technologies Horticulture (article from the internet “Tropical & Sub-Tropical Fruits: Banana” as cited on form PTO-892, herein Ag. Tech).

For claim 1, Ag. Tech teaches a method of propagating a species of the genus *Musa*, comprising the step of: (a) planting one or more whole defoliated suckers (page 1, under “Propagation”) of the genus *Musa* substantially horizontally (page 1, under “Planting” by two methods, Pit and Furrow, and page 3, under “Orchard establishment and care”, 2nd paragraph, planting in furrows 1.5 to 1.7 meter); and (b) growing one or more plants from each sucker.

For claim 2, Ag. Tech teaches wherein step (a) comprises: (i) providing a furrow in the ground (page 3, under “Orchard establishment and care”); (ii) inserting each whole defoliated sucker substantially horizontally into the furrow (inherent to plant the suckers); and (iii) covering the corm of each sucker with soil while leaving the pseudostem exposed (inherent to cover the corm of the sucker, see throughout article).

For claim 3, Ag. Tech teaches wherein each whole defoliated sucker is oriented in the furrow so that its longitudinal axis is parallel to that of the furrow (pages 1 & 3 as

Art Unit: 3643

mentioned above). Note, since applicant did not specify the furrow's axis, the examiner is considering the sucker to be planted vertical and the furrow's axis that is parallel to the axis of the sucker is vertical axis.

For claim 6, Ag. Tech teaches wherein-step (b) comprises: (i) cultivating the whole defoliated sucker to yield a plurality of vertical offshoots (inherent and discussed throughout the article); (ii) selecting a plurality of vertical offshoots to cultivate and removing the remaining vertical offshoots (page 1, under "After Cares: Desuckering"); (iii) cultivating the selected vertical offshoots to maturity (see pages 1-3).

For claim 9, Ag. Tech teaches the method further comprising the step of (c) cultivating fruit from the plants (page 2, under "Harvesting and Yield").

For claim 10, Ag. Tech teaches the method further comprising the step of (d) picking the fruit (page 2, under "Harvesting and Yield").

For claim 11, Ag. Tech teaches wherein the fruit is banana.

For claim 12, Ag. Tech teaches in a method of propagating bananas from suckers, the improvement comprising planting whole defoliated suckers substantially horizontally (see whole article and above for explanation).

For claim 13, Ag. Tech teaches bananas prepared by the method of claim 1.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 4,5,7,8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ag. Tech (as above).

For claims 4 & 5, it would have been obvious to one having ordinary skill in the art at the time the invention was made to plant the suckers of Ag. Tech pairwise, depending on the available land space and how big the banana variety is.

For claim 7, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select only two vertical offshoots in the step (b)(ii) of Ag. Tech, depending on how many plants one wishes to grow or produce from the offshoots.

For claim 8, Ag. Tech teaches offshoots are removed by pruning or destruction (page 1, under "After Cares").

Response to Arguments

5. Applicant's arguments filed 2/9/05 have been fully considered but they are not persuasive.

Applicant argued that Ag. Tech article does not teach planting the suckers substantially horizontally.

"Substantially horizontally" as defined in Applicant's specification as in furrows; therefore, clearly from the Ag. Tech article that furrows are taught (pages 1 & 3 as explained in the above rejection). Applicant states that the furrows mentioned in the article entail planting vertically and not horizontally; however, it is unclear to the Examiner how Applicant came up with this conclusion when clearly the article states a furrow, which is exactly what Applicant states in the present specification. If Applicant

Art Unit: 3643

believes that the article's furrow is not horizontal, then Applicant should provide evidence that the furrow spoke about in the article is vertical and not horizontal.

Applicant argued that the article does not teach planting suckers pairwise.

The present specification defines pairwise as the suckers being adjacent to one another (page 4 of the present specification). Therefore, technically, the article discusses planting the suckers in furrows, the suckers have to be adjacent to each other within the furrow because a furrow is a long narrow trench, thus, more than one sucker has to be planted therein or else it would be a waste of land space. Since Applicant did not further define "adjacent", one can interpret adjacent as being near by of 1 inch, 1 ft., 2 ft, etc., for those distances are adjacent. In addition, suckers in each furrow can be adjacent too. However, assuming that the article does not teach adjacent, it would have been obvious to one having ordinary skill in the art at the time the invention was made to plant the suckers of Ag. Tech pairwise, depending on the available land space and how big the banana variety is.

Applicant argued that the article teaches away from growing more than one plant from a single planted sucker.

Unfortunately, Applicant's claim language states "growing one or more plants from each sucker"; thus, this is not the same as saying more than one plant. The "or" indicates that one plant can be grown from each sucker. Page 1 of the article under "Desuckering" as pointed out by Applicant is for after cares and not during propagation. Clearly from page 1, under "Propagation" that the article discusses the suckers are propagated. Only the unwanted suckers are destroyed but the wanted ones are preserved

Art Unit: 3643

and employed in propagation process. In any event, one can assure at least one plant results from the sucker propagated.

Applicant argued that the article does not teach improved yield due to planting suckers substantially horizontally.

The same method is taught in the article and the present invention so if one employs the method of the article, it should produce the same as the present invention. In addition, improve yield has many factors such as the amount of nutrient in the soil, the environment condition, the caretaker/grower dedication, etc., so these factors cannot be considered in weighing what is patentable or not because it depends on the grower adding nutrient or the environment or the like. The tables and examples as provided by Applicant are acknowledge but if the same procedures, assuming no nutrient are added and perfect weather condition for banana growing, are taught in the article, then it should produce the same result as Applicant because nothing in Applicant's method is different from that of the article.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3643

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Son T. Nguyen whose telephone number is 571-272-6889. The examiner can normally be reached on Mon-Thu from 10:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Son T. Nguyen
Primary Examiner
Art Unit 3643

stn